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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,595	10/15/2003	Hiroaki Watanabe	361752002400	1753

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/684,595

Applicant(s)

WATANABE ET AL.

Examiner

D. S. Nakarani

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.  
4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-20 are, drawn to a laminate film, classified in class 428, subclass 457<sup>+</sup>.
  - II. Claims 21-23 are, drawn to a method, classified in class 264, subclass 173.11<sup>+</sup>.
2. The inventions are distinct, each from the other because:
3. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as extruding a polymer film, biaxially orienting the film, applying a metal containing layer and coating directly on the metal containing layer with a solution of EVOH and drying it.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1773

5. During a telephone conversation with Mr. Raj S. Dave on June 17, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 4, the phrase "EVOH layer co-extruded" renders claim indefinite. EVOH layer co-extruded with what? There is no other layer to extrude with EVOH layer specified. Therefore limitation can not be understood.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen et al (U.S. patent 6,740,394 B2) in view of Lykke (U.S. Patent 6,165,571) and Hofmeister et al (6,500,559 B2).

Jacobsen et al disclose a laminate film comprising at least one layer (I) vapor coated with aluminum or SiOx or a metal oxide from main groups 2 or 3, a gas barrier layer (II), at least one further layer (III) vapor coated with aluminum or SiOx or a metal oxide from main groups 2 or 3 and a heat sealable layer (IV), wherein the vapor coated surface of layer (I) is adjacent to the following layer (Abstract) and Examples).

Jacobsen et al disclose that the layers (I) and (III) can be a single layer or multi layer and can be made of identical material or different material (claims 4 and 5). Also the layers (I and/or III) can be at least two layers containing a gas barrier layer (claim 10). The materials for forming layer I and/or III are polyamide, polyester or polypropylene.

Art Unit: 1773

Jacobsen et al's layer II is made of EVOH (col. 2, lines 24-27). Jacobsen et al's bonding adhesive for individual layers can be two pack polyurethane, polyolefinic adhesive etc (col. 3 lines 39-48). Jacobsen et al's layer (IV) is made of polyolefin (col. 3 lines 20-33). Jacobsen et al disclose oxygen transmission (permeability) rate of less than  $0.1 \text{ cm}^3/\text{m}^2/\text{day}$  (col. 2 lines 34-47). Jacobsen et al fail to disclose the layers (I) and/or (III) are biaxially oriented, optical density and claimed adhesive composition.

Lykke discloses a multilayered packaging material comprising biaxially oriented layer (I) made of polypropylene, polyesters, polyamides etc (col. 2 lines 48-63), coated with a barrier layer comprising, EVOH, PVOH, PVDC etc and the barrier layer is metallized with aluminum and a sealing layer banded to a metallized layer (Examples).

Hofmeister et al disclose a multilayer barrier film made using adhesive such as polyurethane, blend of a polyolefin resin and a maleic anhydride modified adhesive resin (col. 8. line 35 to col. 10 line 15, ADH 3, ADH 4, ADH 6). Hofmeister et al also disclose addition of anti-blocking agent in the outer layer (MB1 MB2, MB 3 and MB5). Hofmeister et al disclose thicknesses of individual layers, which falls within claimed range.

Therefore it would have been obvious to a person of ordinary skill in the art at the time of this invention made to utilize disclosure of Lykke and Hofmeister et al in the invention of Jacobsen et al to make the layer (I) of biaxially oriented film as taught by Lykke with thickness taught by Lykke and use Hofmeister et al's teaching of anti-blocking agent, adhesive and thicknesses of individual layers.


No claims are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. S. Nakarani/af  
June 24, 2005

  
**D. S. NAKARANI**  
**PRIMARY EXAMINER**